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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/287,216	04/05/99	BONEAU M	P106-DIV-3-C

RICHARD L KLEIN  
MEDTRONIC AVENUE INC  
3576 UNOCAL PLACE  
SANTA ROSA CA 95403

QM31/1018

EXAMINER

JACKSON, S

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 10/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/287,216

Applicant(s)  
Boneau

Examiner  
Suzette Jackson

Group Art Unit  
3738



☒ Responsive to communication(s) filed on Jul 24, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) 1-3 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 4, 7, 8, 10, 11, 14-19, 22, 23, 25-27, 29, 30, 32, and 33 is/are rejected.

☒ Claim(s) 5, 6, 9, 12, 13, 20, 21, 24, 28, and 31 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

1. Applicant's amendment dated 24 July 2000 has been received in application serial number 09/287,216. Claims 1-3 have been canceled.

#### *Claim Rejections - 35 U.S.C. § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 7-8, 10, 11, 14-19, 22, 23, 25-27, 29-30, 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gianturco 4,580,568 in view of Palmaz 4,739,762 . Gianturco discloses a zig-zag patterned stent in which a multiplicity of stents can be employed depending on the circumstance (col. 5, lines 16-22), however Gianturco does not specify a balloon delivery device. Palmaz teaches the use of delivering stainless steel stents (col. 6, line 42) with a balloon catheter (col. 8, lines 30-68 and col. 9, lines 1-68 see Figures 3 and 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the multiple stents of Gianturco and deploy them using a balloon delivery catheter

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as taught by Palmaz as a way of dilating the diseased blood vessel while at the same time deploying the stent. It is also obvious that endovascular support devices encompass stents.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 4-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. **5,292,331**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of 5,292,331 discloses: “.....compressing a stents onto a catheter, for delivery to an affected area of a vessel and then forcibly expanding to maintain the affected area of a vessel at a diameter larger than if the support device were not implanted. It is obvious to those skilled in the art that stents are delivered with the utilization of balloon catheters which help to break up plaque within a lumen.

8. Claims 4-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. **5,891,190**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of 5,891,190 discloses: “.....compressing each of the plurality of stents onto a balloon catheter, advancing the balloon catheter and the plurality of stents to an area of the vessel, and inflating the balloon catheter to expand the plurality of stents within the area of the vessel . Application 09/287,216 claims these methods with the exception of using “a multiplicity of endovascular support devices”. It is obvious to those skilled in the art that stents are support devices for vascular sites.

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*Allowable Subject Matter*


9. Claims 5, 6, 9, 12, 13, 20, 21, 24, 28, 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wiktor 4,649,922; Palmaz B1 4,739,762; show related material.

10. Any inquiry concerning this communication or earlier communication regarding this application should be directed to examiner Suzette Jackson at (703) 308-6516. If you are unable to reach me, please contact my supervisor, Vincent Millin, at (703) 308-1065. In a case requiring immediate assistance, please call (703) 308-0858 to reach the main operator for Sector 3700.

  
S. Jackson  
12 October 2000

  
David H. Willse  
Primary Examiner